REMARKS

Claims 2 and 7 have been canceled and new claims 10 and 11 have been added to the application. In view of these amendments and the following remarks, a reconsideration and allowance of pending claims 6, 10 and 11 is requested.

Claim 6 has been rejected as obvious in view of Brenman et al and Cory et al. Brenman et al describe a glove having four electrodes built into locations on two fingers and the thumb. This glove is used to stimulate nerves and the only example given is stimulation of nerves in the prostate gland. There is no suggestion in this 1985 patent that its teachings could be used to solve a longstanding problem in anesthesia (Hogan Declaration paragraph 3-7). To applicant's knowledge, no body has thought to use Brenman et al for this purpose in the long, twenty years of its existence.

The Examiner argues that it would be obvious to combine the nerve locating device disclosed in Cory et al with the nerve stimulation device in Brenman et al. This argument is technically wrong for a number of reasons. Cory et al disclose an array of electrodes that are attached to the subject's skin over the region in which a nerve is located. Direct current is applied to these electrodes to measure impedance, and from this information the precise location of an underlying nerve is calculated (Hogan Declaration paragraph 13).

Cory et al teach that an array of electrodes be attached to the subject, not the examining physician. There is no way, therefore, that the Cory et al device could be combined with the Brenman et al teaching that fastens its electrode to a glove worn by the clinician.

Cory et al teach that nerves be located with an array of electrodes by measuring impedance with a low DC current that does not rely on nerve stimulation (Hogan Declaration ¶13 and 14). This is totally incompatible with the approach used by Brenman et al which applies currents sufficient in magnitude to stimulate nerves in the prostate.

Thus, not only is there no evidence that one skilled in this art would think to combine Brenman et al with Cory et al, but it makes no sense from a technical standpoint to even try. The two teachings are incompatible with each other, (Hogan Declaration ¶15 and 17).

Method claim 6 is patentable for the reasons stated in Applicant's previous response. The newly cited Cory et al reference adds nothing of significance to the picture as discussed

above and neither does the newly cited Burgio et al patent. Burgio et al does not stimulate nerves to learn of their location, but is instead an instrument for use in a subject's mouth to deaden the pain prior to a Novocain injection (Hogan Declaration ¶16). Its use presumes the dentist knows where the nerve is prior to use of the instrument.

New claim 10 is an apparatus claim which more clearly distinguishes over the prior art of record. More particularly, the electrode recited in claim 10 includes an adhesive layer that enables the electrode to be removably attached to the distal finger pad of an examining clinician. It is not built into an expensive glove structure as disclosed in Brenman et al and it is not attached to the subject as disclosed in Cory et al. Rather, it is an inexpensive device that can be removed from a sterile package and attached to the clinician's finger during the procedure and then discarded. Typically the clinician will be wearing sterile gloves during the procedure and the electrode is removably attached to their outer surface. New claim 10 and dependent claim 11 are believed to recite patentable subject matter and allowance of the same is requested.

Favorable reconsideration and allowance of this application is respectfully requested.

The Commissioner is authorized to charge any fees under 37 CFR § 1.17 that may be due on this application to Deposit Account 17-0055. The Commissioner is also authorized to treat this amendment and any future reply in this matter requiring a petition for an extension of time as incorporating a petition for extension of time for the appropriate length of time as provided by 37 CFR § 136(a)(3).

Respectfully submitted,

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